

REMARKS

The Examiner indicated that claims 8, 10, 12 and 20 would be allowable if rewritten in independent form to include the limitations of the base claim and any intervening claims. The Examiner also indicated that claims 9 and 11 would be allowable if rewritten in independent form to overcome the 112, second paragraph rejections and include the limitations of the base claim and any intervening claims. Applicant has done this by putting claims 8, 10 and 20 in independent form with claims 9 depending from claim 8 and claims 11 and 12 depending from claim 10.

The Examiner rejected claims 9 and 11 under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, claim 9 was rejected for a lack of antecedent basis for "a tapered slot" and claim 11 for "the locking device". Claims 9 and 11 have been amended to correct this oversight.

The Examiner rejected claims 1-7 and 13-19 under 35 U.S.C. 103(a) as being unpatentable over Duginske (U.S. Patent 5,768,966) in light of Price (U.S. Patent 5,040,443).

The Examiner initially has the burden of factually supporting a *prima facie* conclusion of obviousness, which then shifts the burden of providing evidence for arguments to the Applicant who may submit additional evidence of non-obviousness in order to overcome the Examiner's rejection. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation to combine the references, the three possible sources of which are the nature of the problem to be solved, the teachings

of the prior art, and the knowledge of persons of ordinary skill in the art. MPEP 2143.01, citing In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998). Second, there must be a reasonable expectation of success in combining the references in order for it to be proper to combine them. MPEP 2143.02, citing In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicant submits that the Examiner has failed to establish a *prima facie* conclusion of obviousness, as further discussed below.

Duginske teaches a fence with an inverted L-shaped elongated body having a lower vertical first leg 202 and an upper horizontal second leg 204 extending from the top of lower leg 202. Five T-slots are formed in the fence, two in upper surface of upper leg 204 at 210 and 212, two in the front surface of lower leg 202 at 214 and 216 and one in the back surface of lower leg 202 at 218 between slots 214 and 216 in the front surface. The back surface of leg 202 defines a relatively shallow V-shaped slot disposed below back slot 218, having no disclosed purpose. A groove 227 is formed in the bottom of lower leg 202 for receiving a plastic bearing 229 to facilitate sliding the entire fence across the table when desired. A shallow depression 242 in the front surface is disposed between slots 214 and 216 for receiving a ½"-wide self stick tape ruler which may be used without a wooden fence attached to the front surface or when only a lower wooden fence 230 is used. If an upper wooden fence 228 is used, a similar ruler 241 may be attached on the front

surface thereof. Alternately, a replacement measuring tape 244 may be inserted in one of front slots 214 and 216 or top slots 210 and 212.

A flip stop assembly 56 having a flip stop 10 pivotable about the axis of bolt 68 is provided and is slidable along the length of the fence by loosening knob 58 to loosen the head of bolt 84, which slides in one T-shaped slots 210 and 212 of upper leg 204. Stop 56 may be used with or without wooden fences 228 and 230. When used with the fences (Figs. 2 and 4), the head of bolt 84 is disposed in slot 212 and when used without wooden fences 228 and 230 is disposed in slot 210. When used without wooden fences 228 and 230 (Figs. 3 and 5), a portion of stop 56 adjacent bolt 68 overhangs upper leg 204 adjacent slot 210. If the use wooden fences 228 and 230 were not contemplated, stop 56 would always overhang upper leg 204 as just described.

Price teaches a multiple angle measuring gauge having a fence 25 with a horizontal elongated bottom member 26, an upright member 30 extending vertically upwardly from member 26 and an angled extension member 31 extending upwardly and away from upright member 30. Angled member 31 includes a slot 31a for receiving a tape measure 32, either slidably or permanent secured within slot 31a.

Applicant submits that Duginske and Price cannot be properly combined because there is no motivation or suggestion to do so and no reasonable expectation of success in doing so, as explained below. First, Duginske teaches a movable fence for attaching to the table of a woodworking machine whereas Price teaches a table and fence combination, the table and fence being fixed to one another and more particularly formed integrally in one piece. Thus, there is no

suggestion to combine the immobile angled measuring device of Price to the mobile fence of Duginske. Further, adding the Duginske fence to the table-fence combination of Price would result in the movable Duginske fence sitting atop the Price table with the Price fence and measuring device remaining fixed beside or laterally spaced from the Duginske fence. Thus, there is no reasonable expectation of success in combining these references to reach the claimed invention.

For clarity, Applicant has amended claim 1 to indicate that the planar surface extends outwardly and upwardly from the elongated body and that the slots are attachment receiving slots. For the sake of the arguments in this paragraph only, Applicant assumes that the Examiner would combine Duginske and Price so that the angled member 31 of Price would extend upwardly and outwardly from upper leg 204 of Duginske from the outer end thereof adjacent top slot 210. With this caveat in mind, the overhanging portion of Duginske's stop 56 would interfere with the addition of Price's angled member 31 when used without wooden fences 228 and 230, thus eliminating half of the options available for the use of the Duginske fence. Thus, Duginske teaches away from combining the two references. In addition, the configuration shown in Figs. 20-21 of Duginske teaches an angle connector 330 for securing two pieces of the fence together at an angle whereby connector 330 would interfere with the addition of Price's angled member 31. Duginske thus teaches away from the combination with regard to the ability to use this configuration. Further, Duginske states "The L-shape provides maximum strength in a space saving profile; no part of the shape is more than ½" thick." (Col. 5, ll. 10-12). Duginske's desire to save space is furthered by the various options for

providing a ruler, as discussed above, and includes the option of slidably inserting a replacement tape rule into front and top slots 214, 216, 210 and 212, thereby taking up no more usable space and also providing ruler options for both the vertical and horizontal surfaces of the fence. Duginske's desire to save space thus teaches away from adding another extension, such as Price's angled member 31. Applicant thus submits that Duginske and Price are not properly combined and that claim 1 is therefore allowable.

However, the above argument is limited only to the assumption noted at the beginning of the paragraph. The argument is far stronger when the actual limitation of claim 1 is carefully assessed. Claim 1 recites "an elongated body having a top end including an attachment receiving top end slot, a front face including at least one attachment receiving front slot, and a back face opposed to the front face and including an attachment receiving back slot; a planar face integrally extending outwardly and upwardly, ***from approximately the intersection of the top end and back face***, in an angular manner in relation to the fence body; and a measurement device seated on the planar face." In order for Duginske-Price combination to meet the italicized bold-face portion of claim 1, upper leg 204 of Duginske would have to be removed or made useless, and stop 56 could not function with the result of such a combination. In particular, Applicant's planar face, as claimed, extends "from approximately the intersection of the top end and back face". The "top end" of Duginske is the top 222 from which top slot 212 extends downwardly and the "back face" is the lower leg rear 225 from which back slot 218 extends inwardly. The back

face must be the equivalent of rear 225 because, as claimed, the back face includes a back slot, which can only be slot 218 (or the V-shaped slot therebelow). The intersection of top end 222 and back face 225 of Duginske would thus be at the level of top end 222 within top slot 212. Thus, for the planar surface to extend from approximately this intersection, as claimed, the planar surface would have to extend above upper leg 204 of Duginske, thereby interfering with the ability to use top slots 210 and 212 generally and in particular with stop 56 and rendering useless slots 210 and 212 and stop 56. Thus, there is no reasonable expectation of success in combining the two references to reach the claimed invention.

Even if the two references were combined, they would not teach the claimed limitation. If the two references were combined, it would only possibly make any sense to do so as suggested two paragraphs above, that is, with the planar surface extending from the outer end of upper leg 204 adjacent top slot 210. Thus, even aside from the arguments presented two paragraphs above, the combination of the two references would not teach the claimed limitation, as the planar surface would not extend from approximately the intersection of the top end and back face.

For all the above reasons, Applicant submits that claim 1 is allowable and that claims 2-7 and 13 are allowable as depending from an allowable claim.

In addition, claim 2 has been amended so that the back face has a tapered slot having a tapered surface adjacent to and open to the back face that narrows to a well portion and wherein a locking tab projects adjacent the well portion, thereby incorporating portions of claim 9. Applicant submits that this limitation

makes claim 2 allowable, as it is neither taught nor suggested by the cited references. Duginske simply discloses a tapered, shallow V-shaped slot, which as noted above, serves no disclosed purpose and clearly does not teach or suggest a tapered slot by which an attachment may be attached, nor the above-underlined limitations.

Claim 4 has been amended to correct a typographical error without changing the substance of the claim.

Claim 5 has been amended to correct the lack of an antecedent basis without changing the substance of the claim. With further regard to claim 5, Applicant submits that the cited references fail to teach or suggest plus-shaped grooves. Duginske teaches T-shaped grooves in which either the head of a bolt 84 or jam nuts 234 (Fig. 4) may be disposed whereby the bolt or nuts are threadably engaged to tighten an attachment to the fence. However, Duginske fails to teach or suggest plus-shaped grooves. As noted above, Duginske states "The L-shape provides maximum strength in a space saving profile; no part of the shape is more than 1/2" thick." (Col. 5, ll. 10-12). Duginske's concern for maximum strength in a space saving profile teaches away from plus-shaped slots, as the addition of the portion forming the "plus" shape as opposed to the T-shape amounts to a removal of additional material from the fence, whereby the structure is weakened. Thus, forming plus-shaped slots instead of T-shaped slots in the fence of Duginske would weaken the structure and alternatively, increasing the size of the structure defeats

the space saving profile. Applicant therefore submits that claim 5 is allowable in its own right.

Claim 7 has been amended to correct an antecedent problem without changing the substance of the claim.

Claim 13 has been amended to correct an antecedent problem without changing the substance of the claim.

Further, independent claim 14 has been amended to recite a locking device for securing the fence to the woodworking tool, the locking device being attachable to the fence and including a translating rod with an enlarged head on one end thereof, the rod being insertable through an anchor hole in the locking device, and further including a handle whereby pivotal movement of the handle causes axial motion of the translating rod within the anchor hole such that the enlarged head is movable within the at least one elongated slot of the working surface between an unlocked position and a locked position whereby the locking device is secured to the working surface. Thus, claim 14 includes portions of claim 20. Applicant submits that this limitation makes claim 14 allowable, as it is neither taught nor suggested by the cited references.

Claim 15 has been amended to clarify that the measurement device extends outwardly and upwardly from approximately the intersection of the top end and back face, and the argument with regard to claim 1 is incorporated here as well.

Claim 18 includes plus-shaped grooves and the argument for claim 5 is incorporated here as well.

Applicant has added new claims 21-40 for examination of combinations not previously considered and submits that the new claims are allowable as not being taught or suggested by the cited references, and as further detailed below.

Claim 21 provides a member of which the planar surface is a surface and further clarifies that the member extends from the intersection of the top end and back face, enhancing the argument with regard to claim 1 as applied here.

Claim 22 further clarifies that the member of claim 21 is a wing which angles upwardly and outwardly from the intersection of the top end and back face, also enhancing the argument with regard to claim 1.

Claim 23 incorporates portions of original claim 11. This limitation is neither taught nor suggested by the references, which fail to disclose any mechanism for tilting the fence and a locking device with respect to one another.

Claim 25 claims the general concept of what original claim 2 intended, that is, a tapered slot for affixing an attachment to the elongated body. Applicant submits that the cited references fail to teach or suggest this limitation. As noted above, Duginske teaches a tapered slot in the form of a simple and shallow V-shape, which has no disclosed or apparent functional purpose, especially as it relates to providing a mechanism for affixing any kind of attachment thereby. Clearly, the V-shaped slot of Duginske neither does nor could be used for this purpose. Applicant therefore submits that claim 25 is allowable.

Claim 26 further defines the tapered slot, which clearly defines over the cited references, being neither taught nor suggested thereby.

Independent claim 33 presents the mechanism allowing the tilting ability of the elongated body and a locking device with respect to one another, as noted above in regard to claim 23, the comments regarding which are incorporated here as well.

Claim 34 further defines the tilting mechanism by adding a pair of threaded ports with respective threaded inserts therein, the pair of ports being disposed on opposite sides of the attachment receiving groove by which the locking device is secured to the elongated body.

Independent claim 37 presents a locking device for securing the elongated body to the woodworking tool and includes portions of the limitations of claim 20. Applicant submits that claim 37 is allowable, as the limitations thereof are neither taught nor suggested by the cited references.

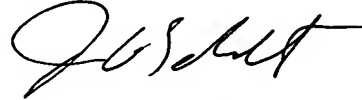
Claim 40 recites that the attachment receiving groove is plus-shaped. Applicant incorporates the argument with regard to claim 5 here as well.

Claim 41 further clarifies that the locking device includes a cam surface for translating rotational movement to axial movement. Applicant submits that this limitation is not taught or suggested by the cited references.

In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal notice of allowability for the claims. Please call the undersigned attorney if any questions remain after this amendment.

Respectfully submitted at Canton, Ohio this 16th day of December, 2003.

SAND & SEBOLT

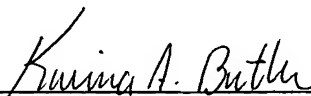


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